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EXAMINER

BORIN, MICHAEL L

ART UNIT

PAPER NUMBER

1631

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### **DETAILED ACTION**

Response to restriction requirement filed 05/06/2008 is acknowledged.

Applicant elected, without traverse, Group I, claims 1-6, 8-14, 16, 20-23, 49-52, 74-97, 121-126, drawn to a method for constructing a variant set for an antibody.

Claims 66-68, 98-100 and 127 are canceled.

Claims 1-6,8-14,16,20-23,49-52, 74-97,121-126 are pending.

### ***Election of species requirement***

Pursuant to election of species requirement, applicant made the following elections:

For Group A - Rule for step a), selected from those listed in claim 6 - applicant elected (ii) a physico-chemical property of an amino acid at a position within a plurality of antibody sequences as set forth in claim 6

For Group B - A descriptor of first value, selected from i), ii), or iii) from claim 8 – applicant elected (i) a substitution at a position in said plurality of positions represented by all or said portion of the variants

For Group C - A modeling step d), selected from those in claims 11,12 - applicant elected computation of a generalized additive model as set forth in claim 11.

Claim 12 is withdrawn from consideration as drawn to non-elected species.

Further, with respect to election of species requirement, first, while applicant made the elections, Examiner now acknowledges that requiring elections from Groups D and F separately resulted in conflicting elections; for example claims 16 and 20 are non-elected for species Group D, but are elected claims for species Group F. To resolve this ambiguity, the election of species requirement is re-stated below, with Groups D and F combined into Group D.

Second, with respect to Group E - A property measuring step - the election of species requirement is revised to include more claims directed to further property steps of step (c) of claim 1.

The following elections of species are required:

- D. Type of further step performed in addition to the steps of claim 1, selected from the following: addressed in claims 2,3, or addressed in claim 4, or addressed in claim 13, or addressed in claim 16, or addressed in claim 20, or addressed in claim 21, or addressed in claim 22, or addressed in claim 23.
- E. A further step in step c), selected from those in claims 49-51, or claim 81, or claim 82, or claims 83-84, or claim 85, or claim 87, or claim 89, or claims 91-92, or claims 93-94.

Applicant is required under 35 U.S.C. 121 to make a re-election of a single disclosed species from group (F), AND group (E).

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (571) 272-0713. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571)272-0720 . The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Borin, Ph.D./  
Primary Examiner, Art Unit 1631

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